UNITED STATES PATENT AND TRADEMARK OFFICE

DR

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/503,166 | 02/14/2000 | Joseph A. Yaccarino III | X-9304 | 6169 |

7590 01/13/2004

Gipple & Hale
6665-A Old Dominion Drive
McLean, VA 22101

| EXAMINER | |
|---|---|
| PHAN, HIEU | |
| **ART UNIT** | **PAPER NUMBER** |
| 3738 | 23 |

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Paper No. 23

Application Number: 09/503,166
Filing Date: February 14, 2000
Appellant(s): YACCARINO III ET AL.



John S. Hale
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/24/2003.

***(1) Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

***(2) Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

***(3) Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 13-28 and 33-37 have been canceled.

***(4) Status of Amendments After Final***

No amendment after final has been filed.

***(5) Summary of Invention***

The summary of invention contained in the brief is correct.

***(6) Issues***

The appellant's statement of the issues in the brief is correct.

***(7) Grouping of Claims***

The rejection of claims 1-12 and 29-32 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

***(8) Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

***(9) Prior Art of Record***

| | | |
|---|---|---|
| 6,258,125 | Paul et al. | 7-2001 |
| 5,968,047 | Reed | 2-2000 |

(10) ***Grounds of Rejection***

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-12 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (U.S. Patent 6,258,125) in view of Reed (U.S. Patent 5,968,047).

Paul et al. teaches an intervertebral allograft spacer (50, 80) with portions (52, 54) having complimentary and interlocking mating surfaces (56, 58, 82, 84, 86) with plurality of angularly aligned holes (66) and pins (64) as is claimed (Abstract, figures 6-8B and 11, column 2 lines 13-43, column 3 lines 26-59, column 4 lines 27-67 and column 5 lines 1-7). Regarding 1-12 and 29-32, Paul et al. failed to disclose the fastener is threaded, a threaded bolt and nut, knurled rod or a demineralized rod.

Reed teaches different type of demineralized fixation devices such as a screw (80) or rod (90, 100) (Figures 20A and 21A-22, column 2 lines 18-67, column 3 lines 9-26, column 5 lines 28-67 and column 6 lines 1-14). The advantage of using the demineralized fixation devices is the demineralized devices help to prevent an immune

system response by the patient. Further, the shape of the device help to better secures an implant.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of Reed to modify the apparatus Paul et al. to have the fastener is threaded, a threaded bolt and nut, knurled rod or a demineralized rod. The motivations for incorporating the feature of Reed into the apparatus of Paul et al. are the demineralized devices help to prevent an immune system response by the patient and the shape of the device help to better secure an implant.

***(11) Response to Argument***

For the above reasons, it is believed that the rejections should be sustained.

The following ground(s) of rejection are applicable to the appealed claims:

Even though the continuation application of Paul et al. (U.S. Patent 6,258,125) has added Joseph A. Yaccarino, III as an inventor, and United states Patent number 6,025,538, of which the present application is continuation-in-part, added David C. Paul as inventor, does not over come the fact that both patents ('125 and '538) have a different inventive entity and assignee. Due to the fact that the inventive entity and assignee are different, the rejection under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (U.S. Patent 6,258,125) in view of Reed (U.S. Patent 5,968,047) is proper.

In regard to the Declaration 1.131 filed in Paper No. 16, examiner concluded that the Declaration 1.131 insufficient because the declaration does not satisfy the criteria of section of the MPEP 715, which states:

## 37 CFR 1.131 Affidavit or declaration of prior invention.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

In regard to applicant's traverse the combination of Paul et al. (U.S. Patent 6,258,125) and Paul et al. (U.S. Patent 6,258,125) in the rejection of claims 1-12 and 29-32 under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (U.S. Patent 6,258,125) in view of Reed (U.S. Patent 5,968,047) in Paper No. 12, examiner disagrees because Reed discloses screws and pines made from human or animal cortical bone tissue to graft live or non-living bone onto or into living bone in the body of a patient. Therefore the rejection of claims 1-12 and 29-32 under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (U.S. Patent 6,258,125) in view of Reed (U.S. Patent 5,968,047) is proper.

Respectfully submitted,

Hieu Phan
Examiner
Art Unit 3738

December 18, 2003

Conferees
Corrine McDermott
Angela Sykes

CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Gipple & Hale
6665-A Old Dominion Drive
McLean, VA 22101

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700